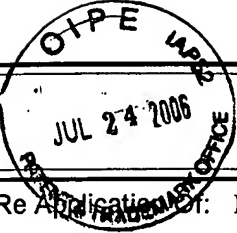


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TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
LEAP:127US

In Re Application Of: **Bonaventura et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/733,628	12/11/2003	Arnel C. Lavarias	24041	2872	1669

Title: **MICROSCOPE STAGE CONTRASTING MEANS**

COMMISSIONER FOR PATENTS:

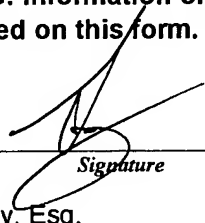
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Dated: **July 21, 2006**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Russell BONAVENTURA et al.

Application No.: 10/733,628

Filed: December 11, 2003

Examiner: Arnel C. LAVARIAS

Group Art Unit: 2872

Confirmation No. 1669

Attorney Docket No.: LEAP:127US

Customer No.: 24041

For: MICROSCOPE STAGE CONTRASTING MEANS



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Honorable Sir:

This Reply Brief is being submitted in response to the Examiner's Answer which was mailed by Examiner Lavarias on May 24, 2006 regarding the final rejection of Claims 1-6, 9-15 and 17-20, as set forth in the Final Office Action dated November 8, 2005. Appellants' Appeal Brief was timely filed on April 14, 2006.

Attorney Docket No.: LEAP:127US
U.S. Patent Application No.: 10/733,628
Appeal Brief dated July 21, 2006

STATUS OF CLAIMS

The application originally contained 20 claims.

Claims 7, 8 and 16 have been canceled.

Claims 1-6, 9-15, and 17-20 stand as finally rejected.

Claims 1-6, 9-15 and 17-20 are the subject of this Appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1-5 and 9-15 (which are separately patentable) are non-obvious under 35 USC §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (*Douglas-Hamilton et al.*) in view of U.S. Patent No. 5,781,338 (*Kapitza et al.*)?
2. Whether Claim 6 is non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (*Douglas-Hamilton et al.*) in view of U.S. Patent No. 5,781,338 (*Kapitza et al.*), and in further view of U.S. Patent No. 4,436,385 (*Fischer et al.*)?
3. Whether claims 17-20 (which are separately patentable) are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (*Douglas-Hamilton et al.*) in view of U.S. Patent No. 4,906,083 (*Sattler*)?

ARGUMENT

In bolstering the rejections of Claims 1-6 and 9-15 the Examiner anchored his argument upon the premise that “there is no requirement to show how teachings in various references are selected.” (See Pg. 9 of Examiner’s Answer). On the contrary, the very foundation of a proper obviousness rejection is that there must be a suggestion or motivation to modify or combine references, and while the references do not have to explicitly suggest the combination, a suggestion or motivation must be shown. *See In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The Examiner is parsing words by delineating between a motivation to combine teachings from references and motivation to combine the references themselves. In either case the same holds true, a motivation or suggestion to combine must be found. The Examiner proceeded to pick and choose elements from the cited references with no valid suggestion or motivation to combine or modify those references. In reply to Appellants’ argument against obviousness, the Examiner states in his Answer that Appellants have provided no evidentiary support to show why removal of the stage insert (holder clamp 20) from the upper stage (cell counter 10) as taught in *Douglas-Hamilton et al.* would not have been an obvious feat to one of ordinary skill in the art. This statement misses the point. The Examiner has proceeded to shift the burden onto Appellants to produce evidence of non-obviousness before a *prima facie* case of obviousness has been made out by the Examiner. It is only after a *prima facie* case of obviousness has been made out by the Examiner that Appellants are required to show evidentiary support of non-obviousness.

The “upper stage” that Examiner Lavarias speaks of is not an upper stage at all, but is an apparatus for measuring cell concentration in a biological sample. Any explanation of the Examiner’s motivation to combine is futile since even if combined *Kapitza et al.* and *Douglas-Hamilton et al.* do not teach all the limitations of the claims. Namely, an upper stage with a recess and a non-transparent contrasting stage insert configured for removable complementarily receipt within the upper stage recess. Therefore, *prima facie* obviousness of the claimed invention has not been established, since all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981 (CCPA 1974).

The Examiner alleges that “the rejected claims do not recite a microscope stage, nor do the recited claims recite any distinguishing structural features related to a microscope.” (See page 10 of Examiner’s Answer). This is a blatant misstatement of the facts. Claims 1, 9 and 17 and all claims dependent from them recite that the claimed invention is a microscope stage in either the preamble or the body of the claim. They do not recite that the invention is a cell counter or a lab instrument, but a microscope stage.

To support his position regarding the present applications relationship to a microscope stage, the Examiner argues that preambular language is “not afforded significant patentable weight unless structurally distinguishable from the prior art.” (page 11 Examiner’s Answer). This is not the correct standard for determining the weight of language in the preamble. “If a claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The phrase “microscope stage” is what gives the claim meaning. It is only from the phrase “microscope stage” that “the subject matter defined by the claims is comprised” as a microscope. *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951). Therefore, the Examiner’s position that the claims are unrelated to a microscope stage, or that the preamble should not be given significant patentable weight are both incorrect. Consequently, all the elements of Claims 1-6 and 9-15 are not taught by the combination of *Kapitza et al.* and *Douglas-Hamilton et al.*

In his Answer, the Examiner states that it was appropriate to broadly interpret holder clamp 20 to read on the limitation of “a non-transparent contrasting stage insert comprising a second color,” and that arguments from Appellants arguing that this interpretation is overly broad are unfounded. (page 13 Examiner’s Answer). The Examiner reasoned that Appellants’ argument, that the holder clamp 20 can not provide a background color for contrast against a specimen that is being positioned on a stage, was an attempt to import limitations from the specification into the claims. However, Appellants’ were not attempting to import limitations into the claims, but were providing real life applications to highlight the advantages of the

claimed invention (e.g., showing that a stage insert that is a different color than the upper stage provides the advantage of better location and positioning of specimens on a microscope stage). This was done also to highlight the lack of teaching in the cited references of “an upper stage comprising a first color” and “a non-transparent contrasting stage insert comprising a second color different from the first.” This contrast in colors between the claimed insert and upper stage facilitates positioning and better viewing of specimens on the stage.

The Examiner contends that Claim 9 fails to recite a “non-transparent contrasting stage insert comprising a second color different from a first color of the upper stage.” Interpreting Claim 9 which recites “an upper stage comprising a first color; and a non-transparent contrasting stage insert comprising a second color ...” The purposeful recitation of a first color and second color in a single claim was intended to portray that the first color and second color are two different colors. Any other interpretation would be absurd. There is no other reason to recite a first color and a second color, outside of trying to distinguish the two colors as different.

The Examiner cites *In re Keller* for the proposition that obviousness can not be argued against by individually attacking references cited, where the rejections are based on combinations of references. However, this proposition is not what *In re Keller* stands for, and an obviousness rejection can be dismantled by showing that an individual reference is missing an element of a rejected claim that it is purported to teach. For example, Appellants have argued that *Statler* and *Douglas-Hamilton et al.* each fail to teach a non-transparent contrasting stage insert, so the obviousness rejection falls short due to both individual references being shown to miss the non-transparent contrasting stage insert. Obviousness rejections still must teach or suggest all the claim limitations, and demonstrating that individual references when combined do not teach or suggest a claim limitation can be used to overcome an obviousness rejection.

In Appellants’ brief a request is made for Judicial notice be taken to adopt a definition for non-transparent to mean “to allow light to travel through it.” Thus, a *non*-transparent specimen holder would not allow light to travel through it. In his Answer, the Examiner contests that the term non-transparent should be defined as translucent and opaque, two terms that are incongruous. The Examiner argued that the specification of Appellants’ application discloses a

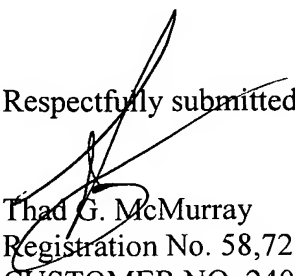
stage insert that can be translucent or non-transparent, and determined from the disclosure of those two embodiments in a single specification that the term has dual meaning, i.e., opaque and translucent. This logic is flawed since specifications often disclose more than what is claimed and describing both translucent and transparent stage inserts is not cause to redefine the term non-transparent. Also, terms are afforded their ordinary understood meaning in the absence a contrary definition. Appellants' specification doesn't define the terms translucent and non-transparent in a manner that is in contradiction with standard definitions. The term non-transparent is defined according to the standard definition (i.e., does not transmit light) in Appellants' specification, and translucent is defined according to the standard definition as well (i.e., transmits light). Further support for the definition put forth by Appellants is the fact Claims 1, 2, 4, 9, 10, 11, 12, 13, 14, 15, 17-19 were amended to include the term non-transparent to distinguish the claimed invention over *Statler*, a device with a transparent element. Furthermore, the only claim that related to transparent features in the stage insert, Claim 16, was cancelled. Therefore, the Examiner's argument to equate non-transparent to mean translucent is unsupported by the facts in this case or common knowledge among a person of ordinary skill in the art. Therefore, judicial notice should be taken to define non-transparent to mean "to allow light to travel through it."

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CONCLUSION

In view of the foregoing, it is clear that the pending claims are patentable over the cited prior art. Reversal of the rejection in the Final Office Action is therefore respectfully requested.

Respectfully submitted,


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Dated: July 21, 2006
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